REMARKS

Claims 10 and 39-45 are currently pending in the subject application and are presently under consideration. Claims 10, 40, and 45 have been amended herein. Claim 42 has been cancelled. A clean version of replacement paragraphs and all pending claims is found at pages 2-5. A marked-up version showing changes made herein is at pages 11-13.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 10 and 45 Under 35 U.S.C. 102(e)

Claims 10 and 45 are rejected under 35 U.S.C. §102(e) as being anticipated by Ross *et al.* (US 5,859,628). It is respectfully submitted that the present invention, as recited in the subject claims, is not anticipated by Ross *et al.* because this reference fails to teach each and every element recited in the respective claims.

> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Amended claim 10 (which now incorporates the limitation of claim 42), recites to ***a vehicle cradle that also includes an antenna operable to receive order data from the portable terminal, which vehicle cradle couples to a wide area network via a wide area network access point to transmit the order data over the wide area network.*** (p. 32, lines 7-11).

The subject invention, in another aspect thereof with respect to claim 45, relates to vehicle cradle for removably receiving a portable terminal in a motorized vehicle, the vehicle cradle having a communication port for ***receiving order data from the portable terminal, and a signal transmitter for transmitting the order data received from the portable terminal over a wide area wireless communication network to an order server.***

Ross *et al.* neither discloses nor suggests the aforementioned limitations recited in independent claims 10 and 45 (and claims 43 and 44 which respectively depend from claim 10). Accordingly, withdrawal of this rejection is respectfully requested.

II. Rejection of Claims 39-44 Under 35 U.S.C. 103(a)

Claims 39-44 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ross *et al.* in view of Ruppert *et al.*, (US 5,640,002). Initially, it is noted that claims 42-44 depend from claim 10 – the Office Action indicated a contrary dependency relationship. Thus Applicant's comments under Section 103(a) are directed principally to claims 39-41. Withdrawal of this rejection is respectfully requested for at least the following reasons.

The subject invention, in another aspect thereof with respect to claim 39, relates to ***a system for fulfilling orders placed from a remote computer***. The system comprises ***a communication network for communicating an order from the remote computer to a central order processor***, the order including a customer destination location for delivering a completed order; a portable terminal having a data communication network connection for retrieving the order from the central order processor; and a vehicle cradle for mounting on a motorized delivery vehicle for delivering goods to the customer destination location, the vehicle cradle including a housing for removably receiving the portable terminal, a power management system for delivering power to the portable terminal, and a communication port for communicating data from the vehicle cradle to the portable terminal. The portable terminal is operable within the vehicle cradle and at a location remote from the vehicle cradle.

As conceded in the Office Action, Ross *et al.* fails to disclose or fairly suggest a communication network for communicating an order from the remote computer to a central server. Thus Ross *et al.* fails to teach or suggest all of the claim limitations of independent claim 39.

Ruppert *et al.* discloses a portable RF ID TAG and bar code reader comprising means for users to selects items from a list or plurality of lists to enter an order selection for items to be purchased using a GPS interface. The instant invention further utilizes

such capability in a motorized vehicle, a feature Rupert *et al.* fails to disclose or fairly suggest. Examiner comments that such a modification to the Ross *et al.* system of the Ruppert *et al.* invention would provide much greater flexibility and convenience wherein individuals could either purchase travel items while traveling to their destination, before departure, or at their destination.

It is submitted that there is no motivation to combine Ross *et al.* and Ruppert *et al.*, in the manner suggested in the Office Action.

> [I]t is well known that in order for any prior-art references themselves to be validly combined for use in a prior-art §103 rejection, the *references themselves* (or some other prior art) must suggest that they be combined. The Federal Circuit has consistently held and requires that the Examiner show a motivation to combine the references to create the case of obviousness. That is, the Examiner must show reasons that the skilled artisan, confronted with same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998) (*citations omitted*). Absent some teaching or suggestion in the prior art to combine elements, it is insufficient to establish obviousness by claiming that the separate elements of the invention existed in the prior art. *Arkie Lures Inc. v. Gene Larew Tackle Inc.*, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997). Proof that the separate elements exist in the prior art is inadequate to establish obviousness. *Arkie Lures Inc. v. Gene Larew Tackle Inc.*, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997). The prior art items themselves must suggest the desirability and thus the obviousness of making the combination without the slightest recourse to the teachings of the patent or application. Without such independent suggestion, the prior art is to be considered merely to be inviting unguided and speculative experimentation, which is not the standard with which obviousness is determined. *Amgen, Inc. v. Chugai Pharmaceutical Co. Ltd.*, 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989); *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988); *Hodosh v. Block Drug*, 786 F2f at 1143 n. 5., 229 USPQ at 187 n. 4.; *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1985).

In the instant case, there is no reason provided in the last Office Action to support the proposed combination, other than the statement that "it would have been obvious...to

modify the system of Ross *et al.* by incorporating the shopping capability into the system so users can conveniently shop and update their travel plan while driving or at any remote location." It would not have been obvious to Ross *et al.* to place an order at a grocery store over a wireless network while driving down the road in a motorized vehicle.

The Office Action noted that the combination of Ross *et al.* and Rupert *et al.* produces an advantage, in that "[s]uch modification would provide much greater flexibility and convenience wherein individuals could either purchase travel items while traveling to their destination, before departure, or at their destination." Applicants submit that the fact that the combination produces advantages militates in favor of Applicants because it proves that the combination produces new and unexpected results, and hence, is unobvious.

III. Conclusion

For all the reasons given above, Applicant respectfully submits that the present application is now in full condition for allowance in view of the above amendments and comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,
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MARKED UP VERSION SHOWING CHANGES TO THE SPECIFICATION AND CLAIMS

Please amend the corresponding paragraph of the Related Applications statement at page 1 of the specification as indicated below.

This application is a Continued Prosecution Application of U.S. Patent Application Serial No. 09/487,923 filed on January 19, 2000, which is a [continuation-in-part of United States] Continuation-in-Part of U.S. Patent Application Serial No. [serial no.] 08/780,023 entitled "INTRANET SCANNING TERMINAL SYSTEM" filed on December 20, 1996, [currently pending] and now U.S. Patent No. 6,084,528 granted on July 4, 2000, which is a Continuation-in-Part of U.S. [continuation in part of United States] Patent Application [serial number] Serial No. 08/706,579 entitled "DEVICE AND METHOD FOR SECURE DATA UPDATES IN A SELF-CHECKOUT SYSTEM" filed on September 5, 1996, [currently pending] and now U.S. Patent No. 5,825,002 granted on October 20, 1998.

CLAIMS

Please amend claims 10, 40, and 45 as indicated below.

10. (Thrice Amended) A vehicle cradle for removably receiving a portable terminal in a motorized vehicle used to deliver items to a destination address, the portable terminal being operable at a location remote from the vehicle cradle and when within the vehicle cradle, said cradle comprising:

a housing configured to allow a user to secure and remove the portable terminal;

a power management system for delivering power to the portable terminal when secured to the housing;

a communication port for communicating data from the vehicle cradle to the portable terminal; and

a GPS system locator coupled to said communication port for generating a location signal and transmitting said location signal to the portable terminal;

wherein the vehicle cradle includes an antenna operable to receive order data from the portable terminal, which vehicle cradle couples to a wide area network via a wide area network access point to transmit the order data over the wide area network to an order server;

whereby the location of the motorized vehicle is transmitted to the portable terminal by the vehicle cradle.

40. (Amended) The system of claim 39 wherein the vehicle cradle [is couple] couples to a wide are network antenna for communicating signals to the central order processor.

45. (Thrice Amended) A vehicle cradle for removably receiving a portable terminal in a motorized vehicle, the portable terminal being operable at a location remote from the vehicle cradle and when within the vehicle cradle, said cradle comprising;

a housing configured to allow a user to secure and remove the portable terminal;

a battery charger for charging a battery within the portable terminal;

a communication port for receiving order data from the portable terminal; and

a signal transmitter for transmitting the order data received from the portable terminal over a wide area wireless communication network to an order server.